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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/823, 534 03/24/97 JOHNSON

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EXAMINER

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MERCHANT & GOULD PC
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MINNEAPOLIS MN 55402-0903

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NGUYEN, C	ART UNIT	PAPER NUMBER
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2165
DATE MAILED:

09/25/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/823,534	Applicant(s) Jerome D. Johnson
Examiner Cuong H. Nguyen	Art Unit 2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 7/11/2001 (the amendment).

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 30-55 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 30-55 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

DETAILED ACTION

1. This Office Action is the answer to the communication received on 7/11/2001, which paper has been placed of record.
2. Claims 30-55 are pending in this application.

Response to Amendment

3. The reply filed on 7/11/2001 is not fully responsive to the prior Office action because: The applicant states that "This communication is in response to the Examiner's Final Office Action dated Jan. 11, 2001", there is no argument to response examiner's rejection on the cited references of 35 USC 103(a); therefore, the examiner considers there is a failure to take complete and proper action within the statutory period. Since the period for reply set forth in the prior Office action may be expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

4. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

Applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

In response to amendment's phrase of "the desired use" is inserted to each independent claims' last line, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

5. Since the applicant agreed to have an telephone interview at 2:30pm on 7/26/2001, the examiner reserved that time slot but there was no call at all from the applicant to initiate the interview.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. The examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

7. In response to applicant's previous argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

8. Since the rejections are based on the examiner's

broadest reasonable interpretation of the claims; In re

Pearson, 181 USPQ 641 (CCPA 1974), the claims are rejected on 35 U.S.C. 103(a) since the cited prior art read on the language of the claims.

A. In re **Conrad**, 169 USPQ 170 (CCPA 1971), the court said: The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

B. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 30-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Girouard et al. (4,982,346) in view of Lockwood et al. (4,359,631), Homma et al. (US Pat. 5,383,111), further in view of Foresman et al. (US Pat. 5,099,422).

Girouard et al. and Lockwood et al. disclose a computerized system for generating a customized, printed

proposal to an individual customer for the individual customer's purchase of a product, the product being characterized by a variety of predetermined distinctive features and environments of product use which are of varying interest to different potential customers who may purchase the product, the customized, printed proposal generated by the system being characterized by pictures and text representative of individualized features and environments which are of particular interest to the individual customer who is to receive the proposal, the system comprising (Girouard et al., col. 1, lines 20-44; Lockwood et al. col. 1, lines 46-68, col. 2, lines 1-14): Girouard et al. disclose :

(a) database means (database files, Fig. 11, item 164, col. 5, lines 6-7), comprising at least one database (product database file, Fig. 11, col. 7, lines 32-40) for storing a plurality of pictures and text related to the product features and environments (product name, product image, col. 7, lines 32-40), the database means comprising:

(I) product picture database means for storing a plurality of predetermined product pictures wherein each picture is related to a distinctive product feature and benefit (product database file, Fig. 11, col. 7, lines 32-40), the plurality of predetermined product pictures being of varying interest to different potential customers who may purchase the product (product name, product image, col. 7, lines 32-40, col. 8, lines, 40-58);

(iii) product text database means for storing a plurality of predetermined product text segments related to distinctive product features (product database file, Fig. 11, col. 7, lines 32-40), the plurality of predetermined product text segments being of varying interest to different potential customers who may purchase the product (product name, product image, col. 7, lines 32-40, col. 8, lines, 40-58);

(b) user interface means for presenting a series of predetermined queries related to the varying interests of the different potential customers (survey, col. 8, lines 21-39), the user interface means comprising input means for selectively inputting (touchscreen, keyboard, Fig. 1, items 28, 30, col. 11, lines 38-58) predetermined answers to the predetermined queries (question file, questions, multiple answers, col. 8, lines 21-39), the predetermined answers corresponding to the individual customer who is to receive the proposal (col. 17, lines 5-36, col. 19, lines 6-51).

However, while Girouard et al. discloses various databases (Girouard et al. col. 5, lines 6-14), printing means (Girouard et al., printer, col. 4, lines 64-68, col. 5, lines 1-2), and linking means for linking the predetermined answers with predetermined pictures (Girouard et al., col. 7, lines 20-40), Lockwood et al. discloses an environment picture database and means for generating a customized printed proposal. Lockwood et al. disclose:

(a) (ii) an environment picture database means for storing a plurality of predetermined environment pictures related to distinctive environments in which the product may be used, the plurality of predetermined environment pictures being of varying interest to different potential customers who may purchase the product (col. 1, lines 57-68, col. 2, lines 1-14, col. 5, lines 3-68); and

© processing means (central processor, col. 4, lines 39-68) for generating the customized, printed proposal, the processing means comprising linking means for linking the predetermined answers with predetermined pictures related to the individualized features and environments which are of particular interest to the individual customer who is to receive the proposal (col. 3, lines 10-41, col. 4, lines 39-68, col. 5, lines 1-6, col. 6, lines 16-21, 56-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the printer means and database of Lockwood et al. in the system of Girouard et al. as providing target marketing in combination with audio-visuals can be used to motivate and influence a customer in promotions or sales (see Lockwood et al., col. 1, lines 21-58).

10. Claims 30-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood et al. (4,359,631), Homma et al. (US Pat. 5,383,111), further in view of Foresman et al. (US Pat. 5,099,422).

A. As to claim 30:

Lockwood et al. obviously suggest a computer system assisted method of generating a customized visual output to facilitate a sale of a product, the computer system comprising one or more computers and storing product images, product environment images and text segments for integration into the customized visual output, the method comprising (see Lockwood et al. col. 1, lines 46-68, col. 2, lines 1-14):

prompting a user of the computer system with a plurality of questions related to at least one of a desired feature and desired use of the product (see Lockwood et al. Figs. 9-10, col. 7, lines 10-66, col. 8, lines 39-50); receiving into the computer system answers to the plurality of questions (see Lockwood et al. Figs. 9-10, col. 7, lines 10-66, col. 8, lines 39-50); automatically selecting, in response to at least one of the received answers, a product image, a product environment image and a text segment (see Lockwood et al. col. 3, lines 10-41, col. 4, lines 39-68, col. 5, lines 1-6, col. 6, lines 16-21, 56-61); and integrating the selected product image, the selected product environment image and the selected text segment into a customized visual output (see Lockwood et al. col. 3, lines 10-41, col. 4, lines 39-68, col. 5, lines 1-6, col. 6, lines 16-21, 56-61).

B. As to claim 31:

Lockwood et al. obviously suggest a step of outputting the customized visual output (see Lockwood et al., col. 3, lines 30-34, col. 6, lines 16-21).

C. As to claim 32:

Lockwood et al. obviously suggest a step of outputting the customized visual output to a computer monitor for viewing by a user (see Lockwood et al., col. 3, lines 11-30, col. 5, lines 49-68, col. 6, lines 16-21).

D. As to claim 33:

Lockwood et al. obviously suggest a the step of outputting the customized visual output comprises printing the output as a printed document (see Lockwood et al., col. 3, lines 11-34, col. 6, lines 16-21, col. 7, lines 41-61).

E. As to claim 34:

Lockwood et al. obviously suggest a step of outputting the customized visual output comprises the step of configuring the printed document as a printed proposal (see Lockwood et al., col. 3, lines 11-34, col. 6, lines 16-21, col. 7, lines 41-61).

F. As to claim 35:

Lockwood et al. obviously suggest a plurality of predetermined environment text segments related to environments in which the products may be used, the method further comprising the step of linking at least one of the customer answers with predetermined environment text (see Lockwood et al., col. 7, lines 10-61).

G. As to claim 36:

Lockwood et al. obviously suggest a method wherein the computer system stores a plurality of product specifications related to producing the products in a variety of configurations, the method further comprising the step of linking at least one of the customer answers with a product specification for inclusion in the customized visual output (see Lockwood et al., col. 3, lines col. 4, lines 62-67, col. 7, lines 10-68, col. 8, lines 1-6, 39-50).

H. As to claim 37:

Lockwood et al. obviously suggest a method wherein the computer system stores a plurality of performance specifications related to performance of the products in a variety of configurations, the method further comprising the step of linking at least one of the customer answers with a performance specification for inclusion in the customized visual output (see Lockwood et al., col. 3, lines col. 4, lines 62-67, col. 7, lines 10-68, col. 8, lines 1-6, 39-50).

I. As to claim 38:

Lockwood et al. obviously suggest a method further comprising the steps of: presenting a series of predetermined queries related to financing a product (requesting information, see Lockwood et al., col. 7, lines 41-68, col. 8, lines 1-6, 48-50); receiving individualized answers to the predetermined queries (received, see Lockwood et al., col. 7, lines 41-61, col. 8, lines 39-50); and generating, for inclusion in the visual output, financing

information related to the product (displayed, see Lockwood et al., col. 7, lines 41-68, col. 8, lines 1-50).

J. As to claim 39:

Lockwood et al. disclose a computer system of one or more computers (computer, see Lockwood et al., Fig. 8, items 30, 42) for generating a customized visual output to facilitate a sale of a product (see Lockwood et al., Figs. 9-10, col. 1, lines 57-68, col. 2, lines 5-15), the system comprising: a memory system (data sources, see Lockwood et al., Fig. 7, item 26), storing product images, product environment images and text segments (see Lockwood et al., Figs. 9-10, col. 5, lines 19-65); a user interface (input interface, see Lockwood et al., col. 2, lines 65-68) provided to prompt a user of the computer system with a plurality of questions related to at least one feature and desired use of the product and to input answers to the plurality of questions (see Lockwood et al., Figs. 9-10, col. 7, lines 41-61, col. 8, lines 39-50); and a processor system (process, see Lockwood et al., Fig. 7, item 30), coupled to the memory systems (data sources, see Lockwood et al., Fig. 7, item 26) and the user interface (input interface, see Lockwood et al., col. 2, lines 65-68), wherein the processor automatically selects, in response to at least one of the input answers, a product image, a product environment image and a text segment and integrates the selected product image, the selected product environment image and the text segment into a customized visual output

(see Lockwood et al., Figs. 9-10, col. 1, lines 57-68, col. 3, lines 10-34, col. 5, lines 29-64, col. 7, lines 41-66).

K. As to claim 40:

Lockwood et al. discloses the user interface provides for visual output of the customized visual output (see Lockwood et al., col. 3, lines 30-34, col. 6, lines 16-21).

L. As to claim 41:

Lockwood et al. disclose a printer for printing the customized visual output as a printed document (see Lockwood et al., col. 3, lines 11-34, col. 6, lines 16-21, col. 7, lines 41-61):

M. As to claim 42:

Lockwood et al. disclose the processor configures the printed customized visual output as a proposal (see Lockwood et al., col. 3, lines 11-34, col. 4, lines 39-68, col. 6, lines 16-21, col. 7, lines 41-61).

N. As to claim 43:

Lockwood et al. disclose the system wherein: the memory system further stores a plurality of predetermined environment text segments related to environments in which the products may be used; and the processor links at least one of the customer answers with predetermined environment text (see Lockwood et al., col. 7, lines 10-61).

P. As to claim 44:

Lockwood et al. disclose the system wherein the memory further stores a plurality of predetermined product specifications related to producing the products in a

variety of configurations; and the processor links at least one of the customer answers with a product specification for inclusion in the customized visual output (see Lockwood et al., col. 3, lines col. 4, lines 62-67, col. 7, lines 10-68, col. 8, lines 1-6, 39-50).

Q. As to claim 45:

Lockwood et al. disclose the system wherein: the memory further stores a plurality of predetermined performance specifications related to performance of the products in a variety of configurations; and the processor links at least one of the customer answers with a performance specification for inclusion in the customized visual output (see Lockwood et al., col. 3, lines col. 4, lines 62-67, col. 7, lines 10-68, col. 8, lines 1-6, 39-50).

R. As to claim 46:

Lockwood et al. discloses a computer readable medium tangibly embodying instructions, which, when executed as a process by a computer system of one or more computers, comprises the steps of: prompting a user of the computer system with a plurality of questions related to at least one of a plurality of desired features and desired uses of the product (see Lockwood et al., Figs. 9-10, col. 1, lines 46-68, col. 2, lines 1-14, col. 3, lines 10-24, col. 4, lines 62-67, col. 7, lines 41-61, col. 8, lines 39-50); receiving into the computer system answers to the plurality of questions (see Lockwood et al., Figs. 9-10, col. 1, lines 46-68, col. 2, lines 1-14, col. 3, lines 10-24, col. 4,

lines 62-67, col. 7, lines 41-61, col. 8, lines 39-50); automatically selecting, in response to at least one of the received answers, a product image, a product environment image and a text segment (see Lockwood et al., Figs. 9-10, col. 1, lines 46-68, col. 2, lines 1-14, col. 3, lines 10-24, col. 4, lines 62-67, col. 7, lines 41-61, col. 8, lines 39-50); and integrating the selected product image, the selected product environment image and the selected text segment into a customized visual output (see Lockwood et al., Figs. 9-10, col. 1, lines 46-68, col. 2, lines 1-14, col. 3, lines 10-24, col. 4, lines 62-67, col. 7, lines 41-61, col. 8, lines 39-50).

S. As to claim 47:

Lockwood et al. disclose a computer readable medium wherein the embodied instructions, when executed by the computer system, further instructs the computer system to carry out the steps of outputting the customized visual output (see Lockwood et al., col. 3, lines 11-34, col. 6, lines 16-21, col. 7, lines 41-61).

T. As to claim 48:

Lockwood et al. disclose a computer readable medium wherein the embodied instructions, when executed by the computer system, further instructs the computer system to carry out the step of outputting the customized visual output to a computer monitor for viewing by a user (col. 3, lines 30-34, col. 6, lines 16-21).

U. As to claim 49:

Lockwood et al. disclose a computer readable medium wherein the embodied instructions to output the customized visual output further instructs the computer system to carry out the step of printing the output as a printed document (col. 3, lines 11-34, col. 6, lines 16-21, col. 7, lines 41-61).

V. As to claim 50:

Lockwood et al. disclose a computer readable medium wherein the embodied instructions further instruct the computer system to configure the printed document as a printed proposal (col. 3, lines 11-34, col. 6, lines 16-21, col. 7, lines 41-61).

W. As to claim 51:

Lockwood et al. disclose a computer readable medium wherein the embodied instructions further instruct the computer system to implement process steps comprising: storing a plurality of predetermined environment text segments related to environments in which the products may be used; and linking at least one of the customer answers with predetermined environment text (col. 7, lines 10-61).

Y. As to claim 52:

Lockwood et al. disclose a computer readable medium wherein the embodied instructions further instruct the computer system to implement process steps comprising: storing a plurality of product specifications related to producing the products in a variety of configurations; and linking at least one of the customer answers with a product specification for inclusion in the customized visual output

(col. 3, lines col. 4, lines 62-67, col. 7, lines 10-68, col. 8, lines 1-6, 39-50).

AA. As to claim 53:

Lockwood et al. disclose a computer readable medium wherein the embodied instructions further instruct the computer system to implement process steps comprising: storing a plurality of performance specifications related to performance of the products in a variety of configurations; and linking at least one of the customer answers with a performance specification for inclusion in the customized visual output (col. 3, lines col. 4, lines 62-67, col. 7, lines 10-68, col. 8, lines 1-6, 39-50).

AB. As to claim 54:

Lockwood et al. discloses a computer readable medium wherein the embodied instructions further instruct the computer system to implement process steps comprising: presenting a series of predetermined queries related to financing a product (requesting information, col. 7, lines 41-68, col. 8, lines 1-6, 48-50); receiving individualized answers to the predetermined queries (received, col. 7, lines 41-61, col. 8, lines 39-50); and generating for inclusion in the visual output, financing information related to the product (displayed, col. 7, lines 41-68, col. 8, lines 1-50).

AC. As to claim 55:

Lockwood et al. disclose a computer system assisted method of generating a customized visual output to facilitate a sale of a ware offered for sale to a customer (col. 1, lines

56-68), the computer system storing ware images, ware environment images and text segments for integration into the customized visual output (col. 3, lines 10-34), the method comprising the steps of: prompting a user of the computer system with a plurality of questions relating to at least one of a desired feature and desired use of the ware (Figs. 9-10, col. 1, lines 46-68, col. 2, lines 1-14, col. 3, lines 10-24, col. 4, lines 62-67, col. 7, lines 41-61, col. 8, lines 39-50); receiving into the computer system answers to the plurality of questions; automatically selecting, in response to at least one of the received answers, a ware image, a ware environment image and a text segment (Figs. 9-10, col. 1, lines 46-68, col. 2, lines 1-14, col. 3, lines 10-24, col. 4, lines 62-67, col. 7, lines 41-61, col. 8, lines 39-50); and integrating the selected ware image, the selected ware environment image and the selected text segment into a customized visual output (Figs. 9-10, col. 1, lines 46-68, col. 2, lines 1-14, col. 3, lines 10-24, col. 4, lines 62-67, col. 7, lines 41-61, col. 8, lines 39-50).

Conclusion

11. Claims 30-55 are rejected.

12. Note:

A. In re **Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) the court ruled: "The name of the game is the claim."

B. Although operational characteristics of an apparatus may be apparent from the specification, we will not read

such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. ... discloses a structure that meets the claim limitations.

C. The use of claimed method may be outstanding in its field, but the name of the game is the claim. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

D. Although claims' limitations may be apparent from specification, they will not be read into claims when they can not be fairly connected to structure recited in claims, and since, when given their broadest reasonable interpretation, claims in present application sweep in cited prior art which would have directed artisan of ordinary skill to make cited combination. Therefore, further amendments must be made to improve the form of the claims.

E. About Analogous Art

In re Oetiker , 24 USPQ2d 1443, 1445 (Fed. Cir. 1992), the court ruled: A prior art reference is analogous if the reference is in the field of applicant's endeavor or, if not, the reference is reasonably pertinent to the particular problem with which the inventor was concerned; and in

Lamont v. Berguer, 7 USPQ2d 1580 (BdPatApp&Int 1988), the court ruled: Section 103 requires us to presume that the artisan has full knowledge of the prior art in his field of endeavor and the ability to select and utilize knowledge from analogous arts.

F. The examiner submits that claimed limitations are not original/inventive concepts at all; moreover, these claims have been widely used/applied on retailed business for their generic ideas.

G. In re Heck, 216 USPQ 1038 (CA FC 1983), the court ruled: Similarly relative terms in claims are given broadest reasonable interpretation during patent application's prosecution.

H. In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981), the court ruled: "It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."; and, "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is

what combined teachings of references would have suggested to those of ordinary skill in art."

I. Ex parte Rubin, 5 USPQ2d 1461 (BdPatApp&Int 1987); the court ruled: Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

J. In re Susi, 169 USPQ 423 (CCPA 1971), the court ruled: Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments.

K. In re Heck, 216 USPQ 1038 (Fed. Cir. 1983) the court ruled: "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can be reached on Mon.-Fri. from 7:00 AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

08/823, 534
Art Unit 2165

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 308-9051/746-5572

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Cuong Nguyen

Sept. 19, 2001